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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,263	10/21/2003	Dominik J. Schmidt		4606
21906	7590	11/17/2006		
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631				
			EXAMINER FRANKLIN, RICHARD B	
			ART UNIT 2181	PAPER NUMBER

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,263	SCHMIDT, DOMINIK J.	
	Examiner	Art Unit	
	Richard Franklin	2181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

A3M
FRITZ FLEMING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100
11/15/2006

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 20 are pending.

Reopening of Prosecution After Appeal Brief


2. In view of the Appeal Brief filed on 18 September 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


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11/15/2006

Election/Restrictions

3. Newly submitted claims 11 – 20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Newly submitted independent claim 11 is directed to a combination claim. Newly submitted independent claim 17 is directed to a mode selection and coupling method. Both of the independent claims would have been restricted in the first office action if they had been presented when prosecution had begun.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11 – 20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

4. Applicant's arguments filed on 09 February 2006 have been fully considered but they are not persuasive.

As per Applicants argument of the 35 U.S.C. § 102(b) rejection of independent claim 1, Applicant argues that the relied upon reference, US Patent No. 5,793,989 (hereinafter Moss), does not teach a common set of pins coupled to the first and second interface circuits and a host computer bus, or that the common set of pins are user selectable to communicate with the host computer bus in accordance with either a first or second bus standard. Examiner submits that Moss does teach all of the limitations of

Art Unit: 2181

amended claim 1. Moss teaches a common set of pins (Figure 1 Item 105) coupled to the first and second interface circuits (Figure 1 Items 112 and 113) and a host computer bus (Figure 1 Item 127). Moss also teaches that the common set of pins are user selectable to communicate with the host computer bus in accordance with either a first or second bus standard because the user ultimately in the end selects the pin format. Socket Logic Unit (Figure 1 Item 109) represents the "user selectable" function because it selects the mode of common set of pins (Figure 1 Item 105).

As per Applicants arguments of the 35 U.S.C. § 103(a) rejection of claims 7 and 8, Applicant argues that the relied upon reference, US Patent No. 5,793,989 (hereinafter Moss), does not teach an interface circuit that formats signals on an internal bus that is coupled to both interface circuits. Applicant argues that in Moss, dedicated busses exist (Figure 1 Items 114, 115, 116, and 119), each of which provides signals on only a single standard to the interface circuits. Examiner submits that the signals on the internal busses (Figure 1 Item 115 and 119) are formatted by the interface circuits (Figure 1 Items 112 and 113) to a format that is appropriate to be sent on the internal radio busses (Figure 1 Items 114 and 116).

5. In response to Applicant's Appeal Brief filed on 18 September 2006, the Examiner has re-opened prosecution in order to fix the statutory basis of the rejection of claim 4. Applicants Appeal Brief pointed out an error in the statutory basis of the rejection of claim 4. Applicants amendment filed on 09 February 2006 amended claim 4

to be dependent from claim 3. Since claim 3 is rejected under 35 USC 103(a) in view of Moss and Tyson, the rejection of claim 4 has been changed from a rejection under 35 USC 102(b) in view of Moss to a rejection under 35 USC 103(a) in view of Moss and Tyson. The Examiner notes that this error was not pointed out in the pre-appeal conference request filed on 17 July 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 2, and 5 – 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Moss et al. US Patent No. 5,793,989 (hereinafter Moss).

As per claim 1, Moss teaches a first interface circuit conforming to a first bus standard (Figure 1 Item 113); a second interface circuit conforming to a second bus standard (Figure 1 Item 112); and a common set of pins (Figure 1 Item 105) coupled to the first interface circuit and the second interface circuit and a host computer bus (Figure 1 Item 127), the common set of pins being user selectable to communicate with the host computer bus in accordance with either the first bus standard or the second bus standard. The bus standard that is used to send data through the pins is selected by Mode Selecting Means (Figure 2 Item 201) and is controlled by setting a code signal on the address or control lines (Col 3 Line 65 – Col 4 Lines 1, and Col 4 Lines 17 – 27).

As per claim 2, Moss also teaches wherein the common set of pins (Figure 1 Item 105) conforms to the Personal Computer Memory Card International Association (PCMCIA) bus standard (Col 2 Lines 32 – 38).

As per claim 5, Moss also teaches the pins of the connector are connected to a multi-voltage buffer (Col 45 Lines 45 – 53 [tristate buffers]).

As per Claim 6, the first and second circuits are connected to internal busses (Figure 1 Items 114, 115, 116, and 119, Col 2 Lines 32 – 38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,793,989 (hereinafter Moss) in view of "How PCI Works" (hereinafter Tyson).

As per claim 3, Moss teaches a system that allows for the dual function of a peripheral card as described per claim 1 above.

Moss does not teach that one of the bus standards is the Peripheral Component Interconnect (PCI) bus standard.

Tyson teaches that computers use the PCI bus standard to connect to peripherals (Tyson; Page 4 Paragraph 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the PCI bus standard in the system of Moss et al. Using the PCI bus standard in a peripheral allows for utilization of Plug-and-Play (PnP) with the device (Tyson; Pages 5 – 6 [Plug and Play]).

As per claim 4, Moss also teaches wherein the second bus standard is the PCMCIA bus standard (Moss; Figure 1 Item 112, Col 2 Lines 32 – 38).

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al. US Patent No. 5,793,989 (hereinafter Moss).

As per claims 7 and 8, Moss teaches a system that allows for the dual function of a peripheral card as described per claim 6 above.

Moss does not explicitly teach that the first or second interface circuits format signals on the internal busses to be compliant with the first or second bus standard.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the interface units of Moss interpret the signals on the internal busses and formats them into signals compliant with appropriate bus standard because in order to communicate with the radio unit (Figure 1 Item 117), the interface circuits must format data between their respective standard and the standard used by the radio busses (Figure 1 Items 114 and 116) that connect to the radio unit.

9. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al. US Patent No. 5,793,989 (hereinafter Moss) in view of Cahill et al. US Patent No. 6,871,244 (hereinafter Cahill).

As per claims 9 and 10, Moss teaches the system that allows for the dual function of a peripheral card as described per claim 1 above.

Moss does not teach where the system comprises a first or second power supply to supply voltage swings in accordance with the first or second bus standard.

Cahill teaches a system of selecting a bus standard to use similar to that of Moss. Cahill also teach where in the selection, a power conversion is performed when needed by a power supply to convert signal voltages to those appropriate for the bus standard (Cahill; Figure 3 Items 162 and 166, Col 6 Lines 20 – 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the power supply of Cahill et al. in the system of Moss et al. to supply voltages that are compliant with the appropriate bus standard (Cahill et al.; Col 6 Lines 29 – 33).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Jolley et al. US Patent No. 5,832,244 - (hereinafter Jolley) teaches many limitations of the claimed invention. Jolley teaches a first interface circuit (Figure

1 Item 26) conforming to a first bus standard; a second interface circuit (Figure 1 Item 28) conforming to a second bus standard; and a common set of pins (Figure 1 Item 20) coupled to the first interface circuit and the second interface circuit and a host computer bus (Figure 1 Item 18), the common set of pins being user-selectable to communicate with the host computer bus in accordance with either the first bus standard or the second bus standard (Col 4 Line 62 – Col 5 Line 1).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Franklin whose telephone number is (571) 272-0669. The examiner can normally be reached on M-F.

Art Unit: 2181

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fritz Fleming can be reached on (571) 272-4145. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/15/2006